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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,368	12/10/2001	Ronald Hoogendoorn	P 0284116 50800/US	1673
43569	7590	07/19/2006		
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			EXAMINER OGDEN JR, NECHOLUS	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 07/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,368

Applicant(s)

HOOGENDOORN ET AL.

Examiner

Necholus Ogden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by GB (1,122,466).

GB discloses an aviation lubricating composition comprising a complex ester derived from adipic acid, neopentyl glycol and pelargonic acid (page 3, lines 11-21).

As this reference teaches the instantly claimed compound it is considered anticipatory.

2. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by KR (9505692).
3. KR '692 discloses a lubricant composition by reacting neopentyl glycol and adipic acid and reacting the product with a caprylic acid (see abstract).
4. As this reference teaches all of the instantly required it is considered anticipatory.
5. Claims 19, 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP (0415778).

EP '778 discloses a refrigerating oil composition comprising an ester compound as the base oil wherein said base oil comprises an aliphatic polyhydric compound by reacting a neopentyl glycol (page 3, line 22-29); a monocarboxylic acid such as caprylic acid or pelargonic acid; and a dicarboxylic acid such as adipic (page 3, lines 43-58). EP '778 teaches that the composition has a viscosity at 100 degrees Celsius in the range of 1-20 cst (page 3, lines 10-14). EP '778 further teaches that said composition comprises mineral oil (page 5, lines 15-16) and additional additives such as antioxidants, extreme

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pressure additives, oiliness improving agents, defoaming agents and metal deactivators (page 5, lines 28-49).

EP '778 do not teach with sufficient specificity to anticipate the claims, however, it would have been obvious to one of ordinary skill in the art to combine the components to specifically teach the complex ester and additives of the claimed invention since EP '778 teach the esters, acids and additives are well known in the lubricating art.

Response to Arguments

6. Applicant's arguments filed 5-17-2006 have been fully considered but they are not persuasive.

Applicant argues that neither of the references teach or suggest applicant's ester compound.

The examiner contends and respectfully disagrees and directs applicant's attention to reaction product of neopentyl glycol with carboxylic acids such as adipic , caprylic or pelargonic produces applicant's compound of a complex ester within the limitation $n = 1.5-10$.

Applicant further argues that EP '778 is non-analogous art because it teaches refrigerant lubricants and not metal working fluids.

The examiner contends that working fluids and lubricants are considered analogous because they fall under the general compositional art of heat transfer fluids. Moreover, it is held that the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the

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[record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or **intended use** of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir.1997).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 571-272-1322. The examiner can normally be reached on M-T, Th-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Necholus Ogden
Primary Examiner
Art Unit 1751

No
7-14-2006